## REMARKS/ARGUMENTS

By this paper, Applicant responds to the Office Action of December 1, 2005 and respectfully requests reconsideration of the application. The shortened statutory period runs through March 1, 2006. Accordingly, this response is timely.

Claims 1-45 are now pending, a total of 45 claims. Of the independent claims, only claim 34 has not been explicitly allowed.

### I.     Claim 34

Claim 34 is discussed in paragraph 4 of the Office Action in the context of Danish '472 alone. Claim 34 recites as follows:

> 34.     A method, comprising the steps of:
>
> during execution of a program on a computer, recognizing in hardware a condition in which an instruction is to affect the function to be performed by a second instruction, and in response, setting the processor into single-step mode;
>
> taking a single-step exception after executing the second instruction, and setting the processor out of single-step mode.

### A.     Background: The Danish '472 Patent

The Danish '472 patent describes a number of <u>software</u> techniques. For example, a "single step interrupt handler <u>routine</u>" (Danish '472 col. 3, line 30), replacing data received from a keyboard "under <u>software</u> control" (Danish '472, col. 3, lines 24-25), a "keyboard interrupt handler <u>routine</u>" (Danish '472, col. 3, lines 36-37), etc.

Danish's software executes in normal one-instruction-after-another fashion, except for ordinary X86 "hardware interrupts" and "single step" interrupts, essentially the same as the X86 "interrupts" and "single step" features previously addressed in connection with the Alpert '679 patent.

### B.     Claim 34 is Patentable on the Merits

Because the Office Action is rather vague, Applicant is unable to respond directly. However, in an effort to advance prosecution, and without conceding that the Office Action is sufficient to create a rejection, Applicant notes as follows.

FROM WILLKIE FARR 37FAX DEPT        (WED) 3. 1'06 15:57/ST. 15:56/NO. 4261629815 P 4

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Attorney Docket No. 114596 29-000125BS
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Perhaps the claim step of "recognizing in hardware a condition" is thought to correspond to the "single-step interrupt handler" of Fig. 2. However, Danish '472 makes clear that his "single-step interrupt handler," like any other conventional interrupt handler, is a software routine (Danish '472 col. 3, line 30). Software "routines" are not "hardware" as recited in claim 34.

Because claim 34 recites certain actions to be performed "in hardware" and the closest corresponding structure in Danish '472 is software, any § 102 rejection may be withdrawn.

### C.    Procedural Request

In the telephone interview of August 26, 2005, it was agreed that any future Office Action would precisely identify the relationship between every limitation in the claim and any reference relied upon, by both designating the portions of references "as nearly as practicable" and "explaining the pertinence," in the manner required by 37 C.F.R. § 1.104(c)(2). *See* Response of 9/7/2005, at page 16, lines 6-9.

Applicant again requests that particular elements of any reference be precisely designated, for example, by name or by reference number. The explanations provided in the Office Action in square brackets are very helpful in understanding the Examiner's views – a few more will be appreciated. For example, what particular "instruction" of the reference corresponds to the first "instruction" of claim 34? What "second instruction" is "executed," and then "after" execution, the processor is "taken out of single-step mode?"

Applicant also requests that portions of references be designated "as nearly as possible" – a designation of essentially entire col. 3, which discusses two different methods, does not clearly convey the Examiner's view.

### II.    Claims 44 and 45

Claims 44 and 45 are dependent on claim 36. Claim 36 is allowed. If any rejection of claim 44 or 45 was intended, Applicant requests a clearer explanation.

### III.    Conclusion
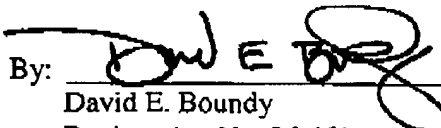
In view of these remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The

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Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely. Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-29-000125BS.

Respectfully submitted,

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